

REMARKS

Claims 1, 4, 6-11, 14 and 16-22 are pending in the application.

Claims 1, 4, 6-11, 14 and 16-22 are rejected.

Claims 11 and 21 are amended to improve readability.

Reconsideration and allowance of claims 1, 4, 6-11, 14 and 16-22 is respectfully requested in view of the following:

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 1, 4, 6-11, 14 and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeman (U.S. Publication No. 2004/0260843) (Sleeman) in view of Saunders (Newcard Exposed) (Saunders), and in further view of Fischer et al (U.S. Patent No. 6,936,936) (Fischer). Claims 9-10 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeman as applied to claim Saunders above, and further in view of Cheng et al (U.S. Patent No. 6,935,130) (Cheng). This rejection is not applicable to the claims. Independent claim 1 includes a "power means including a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the Newcard device."

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, do not teach at least

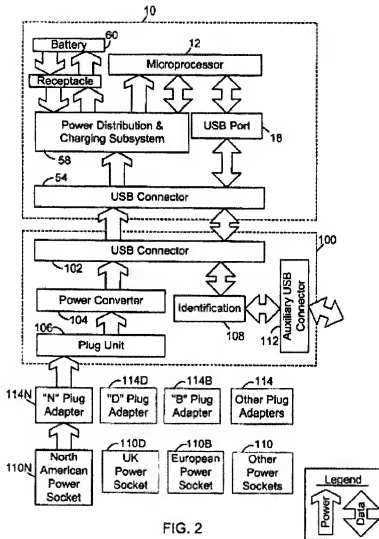
the limitation of a "power means including a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the Newcard device," as required by independent claim 1. (emphasis added)

Sleeman and Saunders do not teach these limitations, nor does the Examiner contend they do. In the most recent Office Action, the Examiner states "Sleeman as modified by Saunders does not explicitly disclose a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline." Office action dated July 16, 2008, page 3.

However, the Examiner argues that Fischer teaches "a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline." Office action dated July 16, 2008, page 4. Applicant respectfully points out the Examiner is neglecting to even consider all elements of the claim. Claim 1 clearly requires deriving power from the computer via a powerline of the Newcard device, not merely a "powerline" as indicated by the Examiner. The Examiner's arguments do not appear to even include an assertion that a powerline of a Newcard device is disclosed by Fischer, in fact, neglecting to provide any indication that the claim limitation is provided by any of the cited references, instead omitting the element from the discussion. MPEP 2143.03 states that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." Quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). As the Examiner has failed to consider deriving power from the computer via a powerline of the Newcard device, for at least this reason, the Examiner has failed to illustrate a *prima facie* case of obviousness.

In addition, the cited portions of the system of Fischer do not provide for deriving power from a powerline of a Newcard device. The Examiner cites to Fig. 2 as teaching a "computer system . . . powered by battery 60 and power adapter 100 via powerline, power distribution system, . . . AC power is supplied to adapter 100 via socket 114N. Power converter 104 has the capability of providing a plurality of power to the computer system." Office action dated July 16, 2008, page 4. Applicant respectfully notes that Fischer teaches that the adapter 100 is

specifically a USB adapter used to couple mobile devices to one or more types of power sockets, and therefore the scope of the art it teaches is very limited. See Fisher, col. 5, lines 46-61. Furthermore, even assuming, *arguendo*, that this USB power adapter 100 provides for the claimed "power adapter," the claimed power means includes an additional element. The additional element, "deriving power from the computer via a powerline of the Newcard device," is not disclosed by the power adapter 100. Fig. 2 including USB power adapter 100 is reproduced below clearly illustrating the lack of a powerline of a Newcard device.



Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms

of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ... [I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Recently, the Supreme Court ruled that the "teaching, suggestion, or motivation (TSM) test" for determining obviousness still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. __, 11 (2007). The Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 14-15, emphasis added.

In the present case, the Examiner has not expressed a reason why a person of ordinary skill in the art would combine Sleeman, Saunders and Fischer. If the Newcard of Saunders is combined with the system of Sleeman to support both PCIE and USB bus protocols, and further combined with the USB converter of Fischer, as suggested by the Examiner, the result would not include the power means required by the claims. The claims combine a Newcard with an additional purpose of deriving power from the powerline of the Newcard, which the suggested combination cannot achieve because the suggested combination would result in power only from a power supply including an AC/DC converter, DC/DC converter, and battery (See Fischer Fig. 2, Col. 7, Lines 16-57). In view of the above, a person of ordinary skill in the art would not

have a reason to combine Sleeman, Saunders, and Fischer. Therefore, there is simply no basis for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the present disclosure without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claims 1, 11 and 21 and their respective dependent claims are submitted to be allowable.


Applicant further notes the rejection of dependent claims 9-10 and 19-20 as being unpatentable over the combination of Sleeman, Saunders and Cheng. Regardless, Cheng does not cure the deficiencies of Sleeman, Saunders. Cheng does not disclose, nor does the Examiner assert that Cheng discloses, a subsystem deriving power from a computer via a Newcard device. Cheng is directed only to a computer cooling system associated with a cooling fan.

In view of all of the above, the allowance of claims 1, 4, 6-11, 14 and 16-22 is respectfully requested.

The amended claims are supported by the original application.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,


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